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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/716,127	11/17/2003	William T. Donofrio	END0745USDIV2	6095
27777	7590	02/22/2010		
PHILIP S. JOHNSON JOHNSON & JOHNSON ONE JOHNSON & JOHNSON PLAZA NEW BRUNSWICK, NJ 08933-7003			EXAMINER NGUYEN, VI X	
			ART UNIT 3731	PAPER NUMBER
			NOTIFICATION DATE 02/22/2010	DELIVERY MODE ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary

Application No.

10/716,127

Applicant(s)

DONOFRIO ET AL.

Examiner

Victor X. Nguyen

Art Unit

3731

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 October 2009.
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 61-64 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 61-64 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/C)
4) ☐ Interview Summary (PTO-413)
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____
Paper No(s)/Mail Date _____

DETAILED ACTION

1. This Office Action is in response to the Amendments filed on 10/29/2009.

Claims 61-64 are pending in this present application.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 61-64 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 61 is unclear what is the power level that the handpiece can operate in a proportion to the monitored pressure? Furthermore, it is unclear how to operate the handpiece at a power level proportional to the monitored pressure.

Clarification is requested.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 61-62 are rejected under 35 U.S.C. 103(a) as being unpatentable over Beuchat et al 5,499,969 in view of Podany et al 6,013,048 and Holland, Jr. et al 6,053,886.

Claims 61-62: Beuchat et al et al disclose an ultrasonic surgical hand-piece (see col. 1, lines 16-20), providing a switch (not shown, see col. 8, lines 40-41) located on a housing; monitoring pressure applied to the switch (see col. 10, lines 16-19;

Beuchat et al et a fail to teach activating the handpiece at a first power level if the monitored pressure reaches a first threshold; deactivating the handpiece if the monitored pressure reaches a second threshold; and providing a switching functionality according to a lagging effect as the monitored pressured is changed or the handpiece operates at a power level proportional to the monitored pressure.

Podany et al teach activating the handpiece at a first power level if the monitored pressure reaches a first threshold; deactivating the handpiece if the monitored pressure reaches a second threshold (col. 4, lines 45-59) or the handpiece operates at a power level proportional to the monitored pressure (col. 7, lines 61-67, col. 8, lines 1-6). It is noted that there will be some indication of pressure as switch 62 is turned on. While activating the hand-piece at a first power level (the first power occurs where the switch 62 is turned on) would permit the monitored pressure reached a first threshold. Alternatively, deactivating the hand-piece would permit the monitored pressure reached a second threshold. It would have been obvious to one having ordinary skill in the art at the same time the invention was made to modify Buechat with activating the handpiece at a first power level if the monitored pressure reaches a first threshold; deactivating the handpiece if the monitored pressure reaches a second threshold as taught by Podany in order to allow the device to operate at a power level corresponding to the desired threshold.

Holland, Jr. et al teach providing a switching functionality according to a lagging effect as the monitored pressured is changed (col. 8, lines 44-46, lines 64-67 and col. 9, lines 1-6). It is well known in the art, specifically *lagging effect can be broadly interpreted as a response time or time delay*, when the pressure applied or forces acted on the switch that are changed (The examiner interprets lagging effect as a time delay, where first delay circuit provides an operational delay... and where a second delay circuit is provided such that a time delay is introduced into the response of the entire system, see Holland, col. 8, lines 46-67).

It would have been obvious to one having ordinary skill in the art at the same time the invention was made to modify Buechat with providing a switching functionality according to a lagging effect as the monitored pressured is changed as taught by Holland in order to provide a response time or time delay, when the pressure applied or forces acted on the switch that are changed.

Claim 63 is rejected under 35 U.S.C. 103(a) as being unpatentable over Beuchat et al in view of Podany et al and Holland, Jr. et al. as applied to claim 61 above and further in view of Culp et al 6,090,123.

The modified method of Beuchat discloses the invention substantially as claimed except for the pressure is monitored by a sensor located inside the housing of the handpiece selected from a group consisting of an electro-mechanical switch, a force-sensitive resistor, force sensitive capacitor, strain gauge, magnet, ferromagnet, piezo film and piezo ceramic. However, Culp et al disclose the pressure is monitored by a sensor located inside the housing of the handpiece selected from a group consisting of an electro-mechanical switch, a force-

sensitive resistor, force sensitive capacitor, strain gauge, magnet, ferromagnet, piezo film and piezo ceramic (fig. 1, col. 64, lines 8-22 and claim 23). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to use the pressure is monitored by a sensor located inside the housing of the handpiece selected from a group consisting of an electro-mechanical switch, a force-sensitive resistor, force sensitive capacitor, strain gauge, magnet, ferromagnet, piezo film and piezo ceramic with the modified step of Beuchat, in order to provide sensing means that is easily mounted in a surgical hand piece (col. 64, lines 8-22 and claim 23), as taught by Culp et al.

Claim 64 is rejected under 35 U.S.C. 103(a) as being unpatentable over Beuchat et al in view of Podany et al and Holland, Jr. et al. as applied to claim 61 above and further in view of Kusunoki et al 5,529,580.

The modified method of Beuchat discloses the invention substantially as claimed except for the switch is generally aligned with a blade as the blade is rotated.

However, Kusunoki et al disclose the switch is generally aligned with a blade as the blade is rotated (fig. 1, element 13, see col. 6, lines 22-29). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to use the switch is generally aligned with a blade as the blade is rotated with the modified step of Beuchat, in order to gain the advantage of cutting the tissue easily (see col. 6, lines 22-29), as taught by Kusunoki et al.

Response to Arguments

4. Applicant's arguments filed 10/29/2009 have been fully considered but they are not persuasive. Applicants state that the cited above references fail to suggest the handpiece operates at a power level proportional to the monitored pressure. Examiner disagrees. In fact, Podany et al teach the handpiece operates at a power level proportional to the monitored pressure (see col. 7, lines 61-67, col. 8, lines 1-6). Furthermore, claim 61 does not positively recite what is the power level that the handpiece can operate in a proportion to the monitored pressure; and therefore the power level proportional to the monitored pressure is interpreted as the surgical handpiece of Podany is responsive and proportional to the pressure applied to the switch 62.

Conclusion

5. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Victor X. Nguyen whose telephone number is (571) 272-4699. The examiner can normally be reached on M-F (8-4.30 P.M).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anh Tuan Nguyen can be reached on (571) 272-4963. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Victor X Nguyen/
Examiner, Art Unit 3731

/Anh Tuan T. Nguyen/
Supervisory Patent Examiner, Art Unit 3731
2/13/2010